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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
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| 09/814,451 | 03/22/2001 | Dekel Shiloh | 3323/1H366US1 | 4579 |

7590 06/24/2004

EITAN, PEARL, LATZER , &COHEN ZEDEK, LLP.
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| EXAMINER | |
|---|---|
| ELISCA, PIERRE E | |

| ART UNIT | PAPER NUMBER |
|---|---|
| 3621 | |

DATE MAILED: 06/24/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

| Office Action Summary | Application No. | Applicant(s) | |
|---|---|---|---|
| | 09/814,451 | SHILOH, DEKEL | |
| | Examiner | Art Unit | |
| | Pierre E. Elisca | 3621 | |

*-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --*

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

1)☒ Responsive to communication(s) filed on *05 May 2004*.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

4)☒ Claim(s) *1-20* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-20* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

**Application Papers**

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

## DETAILED ACTION

1. This Office action is in response to Applicant's Response filed on 5/5/2004.

2. Claims 1-20 are pending.

### *Claim Rejections - 35 USC § 103*

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

4. Claims 1-20 are rejected under 35 U.S.C. 103 (a) as being unpatentable over Fortenberry (U.S. Pat. No. 6,005,939) in view of Dowling et al (U.S. Pat. No. 6,574,239). As per claims 1-5, Fortenberry substantially discloses a password containing user defined information at various security levels is stored in a secure server on the internet (which is readable as Applicant's claimed invention wherein it is stated that a real entity to access a service on a communication network), comprising:

establishing a user account including at least:

first data corresponding to the identity of the real entity (see., abstract, col 1, lines 51-67, specifically password); and

second data corresponding to the virtual entity and not identifying said real entity (see., abstract, col 6, lines 63-67, specifically wherein it is stated that virtual information includes items such as virtual identification that can be used when visiting web sites);

storing said first and second data in a first database (see., col 2, lines 1-13, col 5, lines 62-67, col 6, lines 1-7, first database 214);

linking between said first and second data in said first database (see., col 5, lines 62-67, col 6, lines 1-7);

storing said second data at a second database (see., col 5, lines 62-67, col 6, lines 1-7);

associating said second database with a communication network site (see., col 5, lines 62-67, col 6, lines 1-7);

connecting said communication network site to said communication network (see., abstract, col 5, lines 62-67, col 6, lines 1-7);

receiving said second data from an unidentified user on the communication network site (see., col 6, lines 31-67);

identifying said unidentified user as said virtual user based on receiving said second data (see., col 6, lines 31-67) and

allowing said virtual entity to access said service (see., col 6, lines 63-67). Fortenberry further discloses in response to a user requests, a vendor may request user information such as user name, address, and credit card number (or billing). Fortenberry also discloses a credit card account or information see., col 1, lines 13-22, col 6, lines 52-62. It is to be noted that Fortenberry fails to explicitly disclose that the second database not linked to the first database. However, Dowling discloses a remote entity such as a

virtual session server that has a second database (see., col 6, lines 26-53, col 14, lines 63-67, col 15, lines 1-30. Accordingly, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to modify the teaching of Fortenberry by including a second database as taught by Dowling because this would allow the system databases not to be interconnected.

As per claims 6, and 7-20 Fortenberry substantially discloses a password containing user defined information at various security levels is stored in a secure server on the internet (which is readable as Applicant's claimed invention wherein it is stated that a virtual entity residing on a communication network site), comprising:

a memory having stored therein information defining the virtual entity, which information includes a unique user name, a password and information corresponding to a virtual representation of the virtual entity (see., abstract, col 1, lines 20-37, lines 51-55, col 6, lines 63-67); and

a virtual user interface adapted to communicate with said communication network from said communication network (see., abstract, col 6, lines 63-67);

wherein said virtual entity is not linkable, on said communication network, to the identity of said real entity (see., col 1, lines 51-67, col 6, lines 63-67).

It is to be noted that Fortenberry fails to explicitly disclose that <u>one or more physical attributes or second database not linked to the first database</u>. However, Dowling discloses a remote entity such as a virtual session server that has a second database (see., col 6, lines 26-53, col 14, lines 63-67, col 15, lines 1-30. Accordingly, it would

have been obvious to a person of ordinary skill in the art at the time the invention was made to modify the teaching of Fortenberry by including a second database as taught by Dowling because this would allow the system databases not to be interconnected.

RESPONSE TO ARGUMENTS

5. Applicant's arguments filed on 5/5/2004 have been fully considered but they are moot in view of new ground (s) of rejection.

REMARKS

6. In response to claims 6-11, Applicant argues that Fortenberry cannot be combined, the Examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See In re Fine, 837 F.2d 1071,5 USPQ2d 1596 (Fed. Cir. 1988) and In re Jones, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992).

The rationale to modify or combine the prior art does not have to be expressly stated in the prior art; the rationale may be expressly or impliedly contained in the prior art or it may be reasoned from knowledge generally available to one of ordinary skill in the art, established scientific principles, or legal precedent established by prior case law. In re Fine, 837 F.2d 1071, 5USPQ2d 1596 (Fed. Cir. 1988); In re Jones, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). See also In re Eli Lilli & Co., 902 F.2d 943, 14 USPQ2d

1741 (Fed. Cir. 1990) (discussion of reliance on legal precedent); In re Nilssen, 851 F.2d 1401, 7USPQ2d 1500 (Fed. Cir. 1988) (references do not have to explicitly suggest combining teachings); Ex parte Clapp, 227 USPQ 972 (Bd. Pat. App & Inter); and Es parte Levengood, 28 USPQ2d 1300 (Bd. Pat. App. & Inter. 1993) (reliance on logic and sound scientific reasoning).

Also in reference to Ex parte Levengood, 28 USPQ2d, 1301, the court stated that "Obviousness is a legal conclusion, the determination of which is a question of patent law.

Motivation for combining the teachings of the various references need not to explicitly found in the reference themselves, In re Keller, 642 F.2d 413, 208USPQ 871 (CCPA 1981). Indeed, the Examiner may provide an explanation based on logic and sound scientific reasoning that will support a holding of obviousness. In re Soli, 317 F.2d 941 137 USPQ 797 (CCPA 1963)."

***Conclusion***

7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Pierre E. Elisca whose telephone number is 703 305-3987. The examiner can normally be reached on 6:30 to 5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James Trammell can be reached on 703 305-9769. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Pierre Eddy Elisca

Primary Patent Examiner

June 16, 2004